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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,151	01/25/2002	Yihan Liu	DC4978	9548

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Dow Corning Corporation
Intellectual Property Department
P.O. Box 994
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EXAMINER

JIANG, SHAOJIA A

ART UNIT PAPER NUMBER

1617

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,151

Applicant(s)

LIU ET AL.

Examiner

Shaojia A Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9,10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on September 30, 2003 in Paper No. 7 wherein claims 1-8 and 11 are cancelled and claims 9-10 and 12 have been amended.

Currently, claims 9-10 and 12 are pending in this application.

Applicant's amendment which cancels claims 1 and 11 with respect to the objections for substantial duplicate of claims of record stated in the Office Action dated September 22, 2003 have been fully considered and found persuasive. Therefore, these objections are withdrawn.

Applicant's amendment which cancels claims 1 and amends 9 filed on September 30, 2003 in Paper No. 7 with respect to the rejection of claims 1 and 9-12 made under 35 U.S.C. 112 second paragraph for the use of the indefinite expression, i.e., "a desired molecular weight", of record stated in the Office Action dated September 22, 2003 have been fully considered and found persuasive to remove the rejection since the indefinite expression has been deleted from the claims. Therefore, the said rejection is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-10 and 12 as amended now are rejected under 35 U.S.C. 102(b) as being anticipated by Kasprzak (US 5,443,760) for the same reasons of record stated in the Office Action dated September 22, 2003.

Kasprzak discloses a method of making the instant silicone oil-in-water emulsion composition comprising the particular instant steps for the making herein and the particular components employed in the method (see abstract, col.2-4, and claims 1-8). Kasprzak also discloses the employment of the instant particular components such as the salt, i.e., sodium chloride, aluminum chloride, or ammonium chloride (see col.6 lines 40-45); a lower alkyl alcohol, i.e., ethanol and isopropanol, or a solvent herein such as propyl and octyl esters, fatty alcohols (see col.4 lines 64-68).

Thus, the disclosure of Kasprzak anticipates claims 9-10 and 12.

Claims 9-10 and 12 as amended now are rejected under 35 U.S.C. 102(b) as being anticipated by Gee et al. (US 5,891,954) for the same reasons of record stated in the Office Action dated September 22, 2003.

Gee et al. discloses a method of making the instant silicone oil-in-water emulsion composition comprising the particular instant steps for the making herein and the particular components employed in the method (see abstract, col.2-4, and claims 1-17). Gee et al. also discloses the employment of the instant particular components such as the salt, i.e., ammonium chloride (see col.6 lines 23-30); a lower alkyl alcohol, i.e.,

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ethanol (see Example XIV at col.10 lines 19-20), or a solvent herein such as fatty alcohols, ethers or aromatic compounds (see col.4 lines 58 to col.6 line 58).

Thus, the disclosure of Gee et al. anticipates claims 9-10 and 12.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9-10 and 12 as amended now are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5,443,760 for the same reasons of record stated in the Office Action dated September 22, 2003.

Although the conflicting claims are not identical, they are not patentably distinct from each other. As discussed above, the instant claims 1 and 9-12 are seen to be anticipated by the claims 1-8 of U.S. Patent No. 5,443,760 (see *supra* at page 4).

Claims 9-10 and 12 as amended now are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,593,422 for the same reasons of record stated in the Office Action dated September 22, 2003.

Although the conflicting claims are not identical, they are not patentably distinct from each other. As discussed above, the instant claims 1 and 9-12 are seen to be anticipated by the claims 1-17 of U.S. Patent No. 5,891,954 (see *supra* at page 4).

Applicant's remarks filed on September 30, 2003 in Paper No. 7 with respect to these rejections made under 35 U.S.C. 102(b) and obviousness-type double patenting of record stated in the previous Office Action dated have been fully considered but they are not deemed persuasive to render the claimed invention patentable over the prior art as further discussed below.

Applicant argues that the emulsions of Kasprzak (US 5,443,760) are mechanically prepared and not prepared by emulsion polymerization. However, the instant claims are not seen to be limited to emulsion polymerization but read on the process disclosed by Kasprzak. Moreover, the instant steps recited in the claims are not limited to any specific order and sequence.

Applicant also argues that the silicone polyester in Gee et al. (US 5,891,954) is post added to the silicone oil-in-water emulsion. Nonetheless, as discussed above, mechanically prepared and not prepared by emulsion polymerization. However, the instant steps recited in the claims are not limited to any specific order and sequence,

but read on the preparation in Gee. Further Applicant's argument that Gee also fails to teach the stability of such emulsions therein, is not found convincing. The instant claims are not seen to be limited to any particular stability.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
December 17, 2003



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

12/28/03